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10/624,170	07/21/2003	Raj Bridgelall	1554/SYMBP152US	6362

			EXAMINER
23623	7590	09/15/2006	ZURITA, JAMES H

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ART UNIT	PAPER NUMBER
3625	

DATE MAILED: 09/15/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on <u>21 July 2003</u>.

2a) ☐ This action is **FINAL**.   2b) ☒ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) <u>1-40</u> is/are pending in the application.

    4a) Of the above claim(s) <u>41-112</u> is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) <u>1-40</u> is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☒ The drawing(s) filed on <u>21 July 2003</u> is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a) ☐ All   b) ☐ Some * c) ☐ None of:

      1. ☐ Certified copies of the priority documents have been received.

      2. ☐ Certified copies of the priority documents have been received in Application No. _____.

      3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
    Paper No(s)/Mail Date _____.

4) ☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____.

5) ☐ Notice of Informal Patent Application

6) ☐ Other: _____.

DETAILED ACTION

Prosecution History

On <u>21 July 2003,</u> applicant filed the instant application, without claim to priority.

On 7 June 2006, the Examiner issued a restriction requirement.

On 7 July 2006, applicant responded to the restriction requirement, applicant

elected Invention I, claims 1-40, with traverse.

Election/Restrictions

Applicant's election of claims 1-40 in the reply filed on 7 July 2006 is

acknowledged. Because applicant did not distinctly and specifically point out the

supposed errors in the restriction requirement, the election has been treated as an

election without traverse (MPEP § 818.03(a)).

Drawings

The drawings are objected to because

Reference 322 (page 11, line 30) is missing in Fig. 3.

References 700 and 720 are missing in Fig. 7.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in

reply to the Office action to avoid abandonment of the application. Any amended

replacement drawing sheet should include all of the figures appearing on the immediate

prior version of the sheet, even if only one figure is being amended. The figure or figure

number of an amended drawing should not be labeled as "amended." If a drawing figure

is to be canceled, the appropriate figure must be removed from the replacement sheet,

and where necessary, the remaining figures must be renumbered and appropriate

changes made to the brief description of the several views of the drawings for

consistency. Additional replacement sheets may be necessary to show the renumbering

of the remaining figures. Each drawing sheet submitted after the filing date of an

application must be labeled in the top margin as either "Replacement Sheet" or "New

Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner,

the applicant will be notified and informed of any required corrective action in the next

Office action.

The objection to the drawings will not be held in abeyance.

Specification

The disclosure is objected to because of the following informalities:

On page 20, line 30, "...disposed on the GCN *736*..." appears to refer to GCN

722 of page 20, line 7.

Reference *1018* is variously called RF transceiver section, RF [transceiver]

section, RF [transceiver] section, [RF] transceiver section, [RF] transceiver, RF

[transceiver] section. The terms will be treated as synonyms.

Appropriate correction, if any, is required.

Claim Objections

The following claims are objected to because of informalities:

Various claims appear to require *"...wherein..."* Claims 4-6, for example, should be changed to "...The system of claim 1, *[wherein]* the data input component..."

Claim 1 refers to a "...location-awareness component..." Other claims refer to "...location awareness component...", without the **hyphen**. The claims will be interpreted as referring to the same item.

Claims 16, 17, 19, 27 and 29 refer to "...the secure payment component..." while claims 18 and 39 refer to "...the secure payment system..." There is insufficient antecedent basis for these limitations in the claims, since parent claim 1 refers to "...a payment component..." The claims will be interpreted to refer to "...the payment component [of claim 1] ..."

Claim 25 refers to a "...coordina*ting* component..." other claims refer to "...coordina*tion* component..." The claims will be interpreted as referring to the same item.

In Claim 28 "...wide *are* network..." should be "...wide *area* network..."

Claims 16, 17, 19, 27, 29 and 39 refer to *"...secure...",* a relative term that renders the claim indefinite. There is no definition of an "...insecure..." component, for example and the label appears to be descriptive in nature. For purposes of Examination, the term will be interpreted to refer to systems whose actions are done with cryptography.

Claims 30-32 refer to "...automatically...", a relative term that renders the claim indefinite. The term is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would

not be reasonably apprised of the scope of the invention. For purposes of Examination,

the term will be interpreted to refer to actions that are carried out by computers.

Appropriate correction, if any, is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 7 and 39 are rejected under 35 U.S.C. 112, first paragraph, as failing to

comply with the written description requirement. The claim(s) contains subject matter

which was not described in the specification in such a way as to reasonably convey to

one skilled in the relevant art that the inventor(s), at the time the application was filed,

had possession of the claimed invention.

In Claim 7, the limitation "...in response to which the coordination component

seeks one or more of the bids to transact the list" appears to be based on the following

text and there appears to be no description of how the component "...seeks...":

> ...Once entered into the system 100, the data is transmitted to a central **coordination component** 106 that coordinates a number of system capabilities. More specifically, and as is described in detail hereinbelow, this includes receiving the input data 104 (e.g., article-of-commerce information) from the data input component 102, transmitting the article-of-commerce information to one or more vendors to receive **bid**s for the existing **shopping list**, facilitating location awareness and secure payment. [Page 6, lines 17-22, emphasis added]

For purposes of examination, the limitation will be interpreted to be met where

the user's device receives bids for items on a shopping list.

Claim 39 refers to "...a tag communication process that is prioritized according to

a bandwidth provisioning architecture." The claim appears to be directed to the

following materials:

> The cPDA receives the password and affects the EAS bit within milliseconds of scanning
> both the barcode and associated RFID tag. During this very brief time, the consumer will
> not be aware of the time difference between scanning the item and programming the
> EAS bit. This time latency depends on the speed of the wireless access technology (e.g.,
> IEEE 802.11 alb/g) and network congestion. However, these services may be **prioritized**
> with intelligent **bandwidth provisioning** systems. [page 17, line 18-page 19,line 2m
> emphasis added]

There is no description of how the prioritization of bandwidth provisioning affects

what applicant refers to as "...a *tag* communication process..." or how this process

differs from other types of communication processes.

For purposes of Examination, claim 39 will be interpreted to refer to accelerating

communication by prioritizing bandwidth provisioning.

Claim Rejections - 35 USC

Claims 1-40 are rejected as follows:

claims	35 usc	Reference
1-6, 8-18 22-35 and 40	102(e)	VanErlach (US PG-PUB 20040204063).
7	103(a)	VanErlach in view of Gellman (US PG-PUB 2002/0035536)
19-21	103(a)	VanErlach in view of Freund (US PG-PUB 20030187787)
36-37	103(a)	VanErlach in view of Edgett et al. (US PG-PUB 20040034771)
38	103(a)	VanErlach in view of Grunes et al., US PG-PUB 2002/0113707)
39	103(a)	VanErlach in view of Hoffberg (US 6791472)

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that

form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by
another filed in the United States before the invention by the applicant for patent or (2) a patent
granted on an application for patent by another filed in the United States before the invention by the
applicant for patent, except that an international application filed under the treaty defined in section
351(a) shall have the effects for purposes of this subsection of an application filed in the United States
only if the international application designated the United States and was published under Article 21(2)
of such treaty in the English language.

Claims 1-6, 8-18 22-35 and 40 are rejected under 35 U.S.C. 102(e) as being

anticipated by VanErlach (US PG-PUB 20040204063).

As per claim 1, VanErlach discloses an m-commerce system, comprising

a data input component that receives item data representative Of an article of

commerce (see, for example, at least paragraph 0007, Fig. 3, wireless device 1);

a coordination component that presents the article of commerce to a vendor for

bid (see, for example, at least paragraph 0032);

a location-awareness component that tracks the location of the data input

component (see, for example, at least paragraph 0016); and

a payment component that facilitates payment of the article of commerce (see,

for example, at least paragraph 0017).

As per claim 2, VanErlach discloses that the data input component is a wireless

portable terminal (see, for example, at least paragraph 0002).

As per claim 3, VanErlach discloses that the data input component uploads a

shopping list to the coordination component, which coordination component seeks the

bid for transacting the article of commerce (see, for example, at least paragraph 0013

and Fig. 4).

As per claim 4, VanErlach discloses that the data input component downloads item information from at least one of an appliance and a computer (see, for example, at least paragraph 0028).

As per claim 5, VanErlach discloses that the data input component is in continuous communication with the coordination component (see, for example, at least paragraph 0016).

As per claim 6, VanErlach discloses that the data input component communicates information using a virtual private network (see paragraph 0012; see also Fig. 4, for connection to telcomm service provider).

As per claim 8, VanErlach discloses that the data input component locates the article of commerce via RF backscattering (see, for example, at least paragraph 0012).

As per claim 9, VanErlach discloses that the data input component facilitates receiving the item data by at least one of manual input, a dataform scanning system, an image capture system, an audio input system, a magnetic reading assembly, and an RF transponder reading assembly see, for example, at least paragraph 0007, Fig. 3, wireless device 1).

As per claim 10, VanErlach discloses that the location awareness component includes at least one of a GPS system, a general packet radio services network, and a RTLS architecture (see, for example, at least paragraph 0016)

As per claim 11, VanElrach discloses the coordination component facilitates communication of awareness data to both the data input component and a vendor (see, for example, at least paragraph 0012 and references to retail stores).

As per claim 12, VanErlach discloses that the awareness data communicated to the data input component provides at least one of notification that the vendor is located nearby, and a name and/or an address of the vendor (see, for example, at least paragraph 0030).

As per claim 13, VanErlach discloses that the awareness data communicated to the vendor provides at least one of identification of the user of the data input component and notification that the data input component is located nearby (see, for example, at least paragraph 0015, concerning identifying information about the device or shopper).

As per claim 14, VanErlach discloses that the awareness data facilitates pushing marketing information to the user of the data input component, which marketing information is targeted to the user (see, for example, at least paragraph 0032).

As per claim 15, VanErlach discloses that the coordination component is disposed at least one of remotely on a global communication network and a local backoffice network (see, for example, at least paragraph 0012 and references to the Internet, a global communication network).

As per claim 16, VanErlach discloses that the coordination component coordinates inter-component functions between the data input component (wireless device), the location awareness component (GPS system, for example), and the payment component (see, for example, at least paragraph 0017).

As per claim 17, VanErlach discloses that the secure payment component provides secure communication using at least one of a biometric, radio frequency

identitication (RFID) data, and an article-of-commerce dataform (see, for example, at

least paragraph 0029).

As per claim 18, VanErlach discloses that the secure payment system

distinguishes selection of a first article of commerce from a second article of commerce

by processing both RFID data and dataform data of the first article of commerce (see,

for example, at least paragraph 0012, since each article of commerce has a RFID or

barcode).

As per claim 22, VanErlach discloses that the data input component outputs at

least one of a map and location information that indicates the location of the article of

commerce in a store (see, for example, at least paragraph 0013).

As per claim 23, VanErlach discloses that the data input component receives via

the coordination component, item information associated with the article of commerce

(see, for example, at least paragraph 0013).

As per claim 24, VanErlach discloses that the coordination component retrieves

item information associated with the article of commerce from a vendor data resource,

and downloads the information to the data input component for presentation to the user

(see, for example, at least paragraph 10015).

As per claim 25, VanErlach discloses that the coordinating component manages

a transaction between a user of the data input component and a vendor selected to

provide the article of commerce (see, for example, at least paragraph 0012, see also

references to purchasing via download or physical shipment, as in paragraph 0028).

As per claim 26, VanErlach discloses that the security component facilitates at least one of deactivation and activation of an RFID tag associated with the article of commerce when the data input component reads RFID tag data (see, for example, at least paragraph 0012).

As per claim 27, VanErlach discloses that the secure payment component authenticates the data input component to a store network (see, for example, at least paragraph 0017).

As per claim 28, VanErlach discloses that the location awareness component tracks the data input component in a wide area network and a local area network (see, for example, at lest paragraph 0012, for internet, a wide area network; see also at least paragraph 0016 for local wireless network).

As per claim 29, VanErlach discloses that the secure payment component . utilizes electronic article surveillance (EAS) technology with bi-stable and resettable EAS data in an RFID tag (paragraph 0012).

As per claim 30, VanErlach discloses that the location awareness component automatically updates a vehicle location tracking system to present a location of the vendor offering the bid (see, for example, at least paragraph 0029).

As per claim 31, VanErlach discloses that the location awareness component automatically updates the data input component with store information of a store as the data input component passes within range of a compatible store communication system (see, for example, at least paragraph 0029).

As per claim 32, VanErlach discloses that the data input component

automatically notifies a user that the article of commerce is present in the store (see, for

example, at least paragraph 0012).

As per claim 33, VanErlach discloses that the data input component

automatically notifies a user of a location of the article of commerce in the store (see, for

example, at least paragraph 0013).

As per claim 34, VanErlach discloses that the location awareness component

facilitating synchronization of data of the data input component with a second data input

component over a wireless personal data network (see references to communications

methods with other wireless devices, as in the abstract, for example).

As per claim 35, VanErlach discloses that the coordination component

downloads multimedia content related to the article of commerce to the data input

component in response to the item data being received (see, for example, at least

paragraph 0012).

As per claim 40, VanErlach discloses that the data input component is one of a

cellular telephone and a connected person data assistant (see, for example, references

to cell phone, as in the abstract).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action: .

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set
> forth in section 102 of this title, if the differences between the subject matter sought to be patented and
> the prior art are such that the subject matter as a whole would have been obvious at the time the

invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over VanErlach in view of Gellman (US PG-PUB 2002/0035536).

As per claim 7, VanErlach *does not* specifically disclose that a user of the data input component specifies a price range for a list of the articles of commerce, in response to which the coordination component receives] one or more of the bids to transact the list. This feature is disclosed by Gellman. See, for example, at least paragraph 0036.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine VanErlach and Gellman to disclose that a user of the data input component specifies a price range for a list of the articles of commerce, in response to which the coordination component receives] one or more of the bids to transact the list.

One of ordinary skill in the art at the time the invention was made to would have been motivated to combine VanErlach and Gellman to disclose that a user of the data input component specifies a price range for a list of the articles of commerce, in response to which the coordination component receives] one or more of the bids to transact the list for the obvious reason that a user can thereby be able to buy all the items he needs on a weekly basis at the lowest price.

Claims 19-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over VanErlach in view of Freund (US PG-PUB 20030187787).

As per claims 19-21, VanErlach does not specifically disclose that the payment component facilitates secure communication of item data via a secure key cryptographic engine (claim 19). VanErlach does not specifically disclose that the engine receives as an input at least one of a manufacturer's key, a retailer's key, a unique item ID, and a locate command (claim 20). VanErlach does not specifically disclose that the engine outputs at least one of a product lookup code and a set/reset password (claim 21).

As per claim 19, Freund discloses that the payment component facilitates secure communication of item data via a secure key cryptographic engine. See, for example, at least paragraph 0012.

As per claim 20, Freund discloses that the engine receives as an input at least one of a manufacturer's key, a retailer's key, a unique item ID, and a locate command. See, for example, at least paragraph 0014.

As per claim 21, Freund discloses that the engine outputs at least one of a product lookup code and a set/reset password. See, for example, at least paragraph 0051.

It would have been obvious for one of ordinary skill at the time the invention was made to combine VanErlach with Freund to disclose that the payment component facilitates secure communication of item data via a secure key cryptographic engine (claim 19), that the engine receives as an input at least one of a manufacturer's key, a retailer's key, a unique item ID, and a locate command (claim 20) and that the engine outputs at least one of a product lookup code and a set/reset password (claim 21).

One of ordinary skill at the time the invention was made would have been motivated to combine VanErlach with Freund to disclose that the payment component facilitates secure communication of item data via a secure key cryptographic engine (claim 19), that the engine receives as an input at least one of a manufacturer's key, a retailer's key, a unique item ID, and a locate command (claim 20) and that the engine outputs at least one of a product lookup code and a set/reset password (claim 21) for the obvious reason that cryptographic methods provide payment assurance to counterparties and permits customers and merchants to do business online with greater comfort.

Claims 36-37 are rejected under 35 U.S.C. 103(a) as being unpatentable over VanErlach in view of Edgett et al. (US PG-PUB 20040034771).

VanErlach does not specifically disclose *that* the data input component transmits a unique password to a tag of the article of commerce to facilitate payment for that article of commerce (claim 36). VanErlach does not specifically disclose *that* the tag is an RFID tag that compares the unique password with a password of the RFID tag (claim 37). These features are disclosed by Edgett, as in paragraph 0049, for example.

It would have been obvious to one of ordinary skill the art at the time the invention was made to combine VanErlach and Edgett to disclose *that* the data input component transmits a unique password to a tag of the article of commerce to facilitate payment for that article of commerce (claim 36), and to disclose *that* the tag is an RFID tag that compares the unique password with a password of the RFID tag (claim 37).

One of ordinary skill the art at the time the invention was made would haven

motivated to combine VanErlach and Edgett to disclose *that* the data input component

transmits a unique password to a tag of the article of commerce to facilitate payment for

that article of commerce (claim 36), and to disclose *that* the tag is an RFID tag that

compares the unique password with a password of the RFID tag (claim 37) for the

obvious reason that doing so facilitates returning items by the user to a vendor.

Claim 38 is rejected under 35 U.S.C. 103(a) as being unpatentable over

VanErlach in view of Grunes et al., US PG-PUB 2002/0113707.

As per claim 38, VanErlach *does not* specifically disclose the tag is at least one

of received programmed with the password and programmed with the password at a

time of source marking. This is disclosed by Grunes, paragraph 0016. It would have

been obvious to one of ordinary skill in the art at the time the invention was made to

combine VanErlach and Grunes to disclose that the tag is at least one of received

programmed with the password and programmed with the password at a time of source

marking.

One of ordinary skill in the art at the time the invention was made would have

been motivated to combine VanErlach and Grunes to disclose that the tag is at least

one of received programmed with the password and programmed with the password at

a time of source marking for the obvious reason that a container can be shown to

contain articles of commerce that have not been tampered with.

Claim 39 is rejected under 35 U.S.C. 103(a) as being unpatentable over VanErlach in view of Hoffberg (US 6791472).

As per claim 39, VanErlach *does not* specifically disclose that the secure payment system includes a tag communication process that is prioritized according to a bandwidth provisioning architecture. This is disclosed by Hoffberg, as in Col. 25, line 60-col 27, line 35.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine VanErlach ans Hoffberg to disclose that the secure payment system includes a tag communication process that is prioritized according to a bandwidth provisioning architecture.

One of ordinary skill in the art at the time the invention was made would have been motivated to combine VanErlach and Hoffberg to disclose that the secure payment system includes a tag communication process that is prioritized according to a bandwidth provisioning architecture for the obvious reason that users may be impatient shoppers and may drop a request when it is taking too long to get responses.
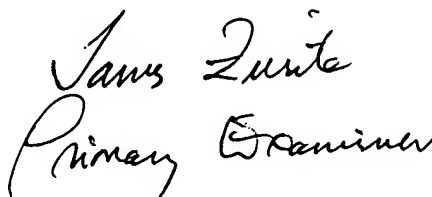
Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to James H. Zurita whose telephone number is 571-272-6766. The examiner can normally be reached on 8a-5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Jeffrey A. Smith can be reached on 571-272-6763. The fax phone number

for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the

Patent Application Information Retrieval (PAIR) system. Status information for

published applications may be obtained from either Private PAIR or Public PAIR.

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you have questions on access to the Private PAIR system, contact the Electronic

Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a

USPTO Customer Service Representative or access to the automated information

system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

James Zurita
Primary Examiner
Art Unit 3625
12 September 2006